

**REMARKS**

Applicants have studied the Office Action dated March 10, 2005 and have made amendments to the claims. Applicants respectfully request entry of this amendment under the provisions of 37 C.F.R. § 1.116(a) in that the amendment and remarks below place the application and claims in condition for allowance, or, at least, present the application in better form for appeal. By virtue of this amendment, claims 1-33 are pending. Claims 1, 11, 18 and 28 are amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- Rejected claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over Picco (U.S. 6,029,045) in view of Zigmond (U.S. 6,571,392).

**Amendments to the Claims**

The Applicants have amended claims 1, 11, 18 and 28 to correct a minor grammatical error. These amendments delete a word "and" that was mis-placed between two limitations of each these claims. The Applicants respectfully assert that these amendments are not substantive, and merely place the claims in better condition for allowance or appeal.

**Rejection under 35 U.S.C. §103(a) Picco and Zigmond**

The Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Picco (U.S. 6,029,045) in view of Zigmond (U.S. 6,571,392). The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole."

The following remarks discuss the Examiner's rejections with specific references to claim 1 in an attempt to simplify the discussion. The Applicants assert that the discussion below with respect to specific portions of claim 1 also applies to the similar limitations also contained within independent claims 11, 18 and 28.

The Applicants traverse the Examiner's assertion that the Picco reference discloses that play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located. Office Action dated March 10, 2005, internal citations omitted. The Examiner cites Picco, column 8, lines 11-22 and column 6, line 57-column 7, line 32. As described below, the cited portions of the Picco reference are limited to broadcasting "local content" to receivers that may contain information identifying that local content, and transmitting "control signals" that describe the "type" of local content to insert. The Picco teachings therefore insert local content into programming based upon a matching of the "type" indicator included in the local content to the "type" specified by the control signals. The teachings of the Picco reference perform this matching either by only storing local content that matches the specified type, or by storing several "types" of local content and retrieving the proper "type" when called upon to insert local content. In addition to the processing described above, the Picco reference further teaches that local content is able to include command and control data that specifies when and how to insert that particular local content.

The Applicants respectfully assert that the "type" matching performed by the processing described by the Picco reference is not a teaching of "pointers" as is recited for independent claims 1, 11, 18 and 28. Claim 1, for example, specifies: "wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located." The Applicants respectfully assert that no data in the Picco reference indicates "where each of the multimedia segments ... is located," but rather only a description of the "type" of data is used to select data from data which is already stored.

In particular, the Applicants respectfully assert that the teachings of the Picco reference include selecting a set of "local content" to broadcast to all receiving stations and also sending "control signals" to the "set-top box" at each receiving station. These control signals indicate which sub-set of the broadcast set of local content is to be stored by the set-top box. Picco, column 7, lines 30-41. These "control signals," or content profiles, "may contain a bitstream of coefficients that indicate, for example, the interest of the household." Picco, column 7, lines 48-53. Picco further teaches that the content broadcast to each household is able to have a "distribution variable" that indicates which households will store, and therefore have available for playback, the particular piece of local content. Picco, column 7, line 61 through column 8, line 6. The private data, which is intended for a particular receiver, is also able to contain command and control data to instruct how that particular private data is to be inserted into the satellite data stream. Picco, column 8, lines 37-39.

The Picco reference further describes that command and control data may be downloaded in real-time with a programming data stream so that the set-top box may determine which local content to insert into a video and at what time to insert that local content into the video. Picco, column 9, line 65 through column 10, line 4. Picco further teaches that programming data can have "local content space" into which "local content" can be inserted. The local content space is also able to include control data that indicates which type of local content may be inserted in that particular local content space. Picco, column 8, lines 16-22, emphasis added.

The Applicants respectfully assert that such control signals that identify a "type" of local content to insert into programming data falls short of "pointers to indicate where each of the multimedia segments ... is located."

With regards to the fourth clause of claim 1, the Applicants further respectfully traverse the Examiner's assertion that Picco discloses "*the play-list contains a multimedia*

*segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered.*" Office Action dated March 10, 2005, page 4, third paragraph, internal citations omitted. The Examiner cites Picco, column 9, lines 10-13 and 40-43. The first cited portion of Picco refers to a graph in the drawings, i.e., FIG. 6 that illustrates the percentage utilization of a satellite channel for the transmission of "programming data" and indicates that the unused capacity is able to be used to transmit "private data." The Applicants fail to see how this teaches "a multimedia segment availability time when the multimedia segment in the play-list is to be received prior" as is suggested by the Examiner. Office Action, page 4, third paragraph. The Applicants point out that this "availability time" is specified in this very limitation as being contained in the "play list."

The second portion of Picco that is cited with regards to the fourth clause of claim 1 states *"the local content is downloaded before insertion for viewing by the user."* Picco, column 9, lines 41-43. The Applicants respectfully assert that the teachings of Picco in this regard are limited to this circumstantial observation that follows from the operation of the Picco system. The Picco system operates by receiving and storing "local content" and then inserting elements of this stored content. Picco, column 6, lines 23-40. This necessarily limits the inserted segments to those which are already received.

The Applicants respectfully assert that the teachings of Picco do not include a "play-list" that is received by the set-top box of Picco, *"wherein the play list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered."* The teachings of Picco do not include specifying any time by which a particular element of local content is to be received. Since the set-top box of Picco inserts local content that has been already received and stored by the set top box, the system of Picco does not require that a particular item of local content to be stored. As discussed above, the Picco reference does not teach or suggest a play-list which identifies particular multimedia segments, and therefore cannot specify a time by which such particular segments should be

received. This characteristic of Picco is in contrast to the presently claimed invention, especially when the claims are considered "as a whole," whereby a play-list is received and that play-list "contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located," and "wherein the play-list contains a multimedia segment availability time" as is set forth in the independent claims for the presently claimed invention.

Furthermore, as the cited references do not teach a "*multimedia segment availability time*," the Applicants respectfully assert that the suggestion for this element can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The references of Picco and/or Zigmond do not even suggest, teach or mention this type of multimedia segment availability time.

The Applicants respectfully traverse the Examiner's assertion that Picco teaches the claim limitation of "*receiving from the program provider the multimedia segments required by the play-list*." Office Action dated March 8, 2005, page 4. paragraph 4. The cited portions of Picco teach deciding which elements of "local content" are to be inserted based upon the "local content" that is available at the uplink facility. Picco, column 6, line 57- column 7, line 32. In particular, Picco states "based on the various information, the schedule then determines the local content that is going to be transmitted by the satellite." Picco, column 7, lines 29-32. The Applicants respectfully assert that the Picco reference is limited to selecting local content to insert from that which is stored at the uplink facility. This is in stark contrast to receiving segments "required by the play-list" as is recited by the independent claims. The order of defining the play-list and receiving the content is reversed in these two cases. The Applicants therefore respectfully assert that such a reverse ordering would cause a modification of

the Picco reference to the presently claimed invention would yield an inoperable system. Since Picco selects content to insert from content that is already received, the system of Picco cannot receive information "required by the play-list." If references taken in combination would produce a "seemingly inoperative device," such references have been held to *teach away* from the combination and thus cannot serve as predicates for a prima facie case of obviousness. *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references *teach away* from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

With regards to the sixth clause of claim 1, the Applicants respectfully assert that the Examiner has not cited teachings for the complete contents of that limitation. The Examiner states that the combination of Picco and Zigmond discloses "*in response to one or more...removable medium.*" The Applicants respectfully point out that this sixth clause includes more than the portion indicated by the Examiner. In particular, the sixth clause begins by reciting: "determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time." The Applicants respectfully assert that this text is to be afforded patentable weight since it is at the beginning of the limitation, and is important when considering the claimed invention "as a whole." The Applicants respectfully assert, for reasons similar to those discussed above, that this portion of the sixth limitation is not taught or suggested by cited references since the cited references do not teach or suggest "a multimedia segment availability time" that is "when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered." The cited references further do not teach or suggest "a multimedia segment availability time" that is contained within a received "play-list" as is set forth in the independent claims when they are considered "as a whole."

With regards to the portion of the sixth clause of claim 1 that is addressed by the Examiner, the Applicants further respectfully traverse the Examiner's assertion that the combination of Picco and Zigmond adequately teach:

in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium

The Applicants assert that the "being so received" in this portion of the limitation refers to the text preceding this portion of the limitation, which recites: "determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time." The Examiner correctly states that Zigmond discloses that if information is not present in local storage of a set-top box, then retrieving that information from the Internet. Zigmond, column 6, lines 60-63. This information in Zigmond is identified by a resource identifier received from the broadcast channel. Zigmond, column 6, lines 24-37. Receiving this resource identifier over the broadcast channel serves as a trigger to display the resource. Zigmond, column 7, lines 20-34. The Applicants respectfully assert that such piecemeal triggering of resource displays, as is disclosed by the Zigmond reference, is not a teaching of a play-list as is recited for the presently claimed invention particularly when considering the description of the play-list provided by preceding limitations of this claim.

The Applicants respectfully assert that independent claims 11, 18 and 28 include similar limitations as those described above with regards to independent claim 1. Accordingly, independent claims 1, 11, 18, and 28 distinguish over Picco, and/or Zigmond for at least the same reasons. Claims 2-10, 12-17, 19-27, and 29-33 depend from claims 1, 11, 18, and 28 respectively. Since dependent claims contain all the limitations of the

independent claims, claims 2-10, 12-17, 19-27, and 29-33 distinguish over Picco and/or Zigmond, as well.

### **CONCLUSION**

In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.




**PLEASE**, if for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call either of the undersigned attorneys at (561) 989-9811 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,

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